

Appl. No. : 10/618,957  
Filed : July 14, 2003

### **REMARKS**

Claim 1 has been amended to clarify the invention. Support for “transparent” can be found in the first complete paragraph on page 5, for example, and support for “cationic compound” can be found in the third complete paragraph on page 12, for example, and support for “configured to maintain transparency after one-hour heat treatment at 150°C” can be found in Example 1 on pages 17-18, for example. Claims 7 and 8 have been added. Support for these claims can be found in the second and third complete paragraphs on page 12, for example. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

#### **Rejection Under 35 U.S.C. § 102**

Claims 1-2 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Wang. Applicant respectfully traverses this rejection.

Wang states:

“The opacity of the PSA stripe is achieved by selecting an opaque plastic base film with sufficient opacity or by applying pigment filled adhesive to the transparent plastic base film. The opacity of the PSA stripe should be greater than 70%. For a transparent base film, an opaque adhesive is needed to give the PSA stripe the required opacity.” (col. 4, lines 10-16)

As is clear from the above, Wang’s stripe is opaque. This is because optical sensing devices installed in copiers or printers require the opaque stripes attached onto transparent sheets to detect the incoming sheets. (col. 1, lines 15-21) In contrast, in claim 1 as amended herein, the transparent protective film is transparent. Surprisingly, due to the presence of the antistatic layer on the base material film, deposit of oligomers existing in the base material film is inhibited even under heated environment, thereby exhibiting excellent heat resistant transparency (e.g., page 5 of the specification). The heated environment is, for example, 150°C for one hour, which may be used for treating transparent conductive substrates. Thus, the transparent protective film can be attached to a transparent conductive substrate prior to heating treatment. Wang’s stripe is opaque and does not require such heat resistance. Thus, Claims 1 and 2 could not be anticipated by Wang. Applicant respectfully requests withdrawal of this rejection.

**Appl. No.** : **10/618,957**  
**Filed** : **July 14, 2003**

Claims 1-2 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hanaoka. Applicant respectfully traverses this rejection.

Hanaoka states:

“In the filter for a display device of the present invention, preferably an antistatic film is formed on a surface of the filter substrate opposite to the surface of formation of the adhesive layer. By this, it further becomes possible to prevent the generation of the static electricity on the display surface of the display device.” (col. 3, lines 46-52) “A transparent antistatic film 16 made of an ITO thin film or other conductive film ...” (col. 5, lines 55-56)

Hanaoka does not teach any specific material other than ITO as an antistatic film. Further, Hanaoka’s filter is clearly not configured to have high heat resistant transparency. The antistatic film is only for preventing the generation of the static electricity on the display surface. The transparent protective film of Claims 1 and 2 as amended herein comprises an antistatic layer comprising a cationic compound, and has excellent heat resistant transparency. Thus, Claims 1 and 2 could not be anticipated by Hanaoka. Applicant respectfully requests withdrawal of this rejection.

#### Rejection Under 35 U.S.C. § 103

Claims 1-2, 4, and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sugawara in view of Hanaoka. Applicant respectfully traverses this rejection.

The Examiner asserts:

“Sugawara fails to teach that the other side of the transparent protective substrate (6) is provided with an antistatic layer. Hanaoka, as discussed above, teaches the advantage of using a protective film with antistatic layer on one and adhesive layer on the other side of the film for preventing buildup of charges on the article. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Hanaoka’s teaching of using an antistatic layer on the other side of the protective substrate (6) in the invention of Sugawara with the motivation to prevent buildup of charges on the article.”

However, first, as explained above, Hanaoka does not teach the antistatic layer recited in Claim 1 as amended herein.

Second, unlike Hanaoka’s display surface, buildup of charges on the surface is not a recognized problem in the transparent protective substrate of Sugawara. Sugawara does not mention the occurrence of buildup of charges on the surface. There is no motivation in Sugawara to use an antistatic layer. The Examiner fails to show that Sugawara has a problem of buildup of charges.

**Appl. No.** : **10/618,957**  
**Filed** : **July 14, 2003**

Third, Sugawara does not mention heat treatment of a conductive substrate together with the protective film. No prior art teaches or suggests use of an antistatic layer in order to prevent white turbiness of the base material film of the protective film during heating treatment.

Thus, there is no motivation to combine the antistatic film of Hanaoka with Sugawara's film, and further, even if they are combined, the antistatic film of Hanaoka is different from that in Claim 1. Thus, Claim 1 could not be obvious over the above references, and at least for the reason, the remaining dependent claims also could not be obvious over the references. Applicant respectfully requests withdrawal of this rejection.

Claims 1-3 and 5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Koyama in view of Hanaoka. Applicant respectfully traverses this rejection.

The Examiner asserts:

"Koyama fails to teach the presence of a protective film thereon. Hanaoka, as discussed above, teaches a surface protective film having an adhesive layer on one side and an antistatic layer on the other side. The protective film is adhered to a support via the adhesive layer to provide protection to the support. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Hanaoka's teaching of using a protective layer adhered to the support substrate with an adhesive layer with the motivation to provide protection to the support."

However, first, as explained above, Hanaoka does not teach the antistatic layer recited in Claim 1 as amended herein.

Second, the Examiner fails to show any motivation or suggestions to use an antistatic layer in Koyama. Koyama does not mention a problem of buildup of charges. Arbitrary connection of Koyama and Hanaoka cannot be justified.

Third, Koyama does not mention heat treatment of a conductive substrate together with the protective film. No prior art teaches or suggests use of an antistatic layer in order to prevent white turbiness of the base material film of the protective film during heating treatment.

Thus, there is no motivation to combine the antistatic film of Hanaoka with Koyama's film, and further, even if they are combined, the antistatic film of Hanaoka is different from that in Claim 1. Thus, Claim 1 could not be obvious over the above references, and at least for the reason, the remaining dependent claims also could not be obvious over the references. Applicant respectfully requests withdrawal of this rejection.

Appl. No. : 10/618,957  
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New claims

Claims 7 and 8 have been added. These claims depend from Claim 1. Thus, at least for the reason, these claims also could not be obvious over the references.

**CONCLUSION**

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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